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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 09/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,521

Applicant(s)

RATZLOFF, JOHN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 15 and 16 have been canceled. Claims 1, 6-8, 13, and 14 have been amended for further examination. Claims 17-19 have been added.

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Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of “one or more discreted flexible connecting strips mounted between the mounting strip and the printer paper sheet” as stated in Claim 8, lines 4 and 5; and in Claim 13, lines 2 and 3, must be shown or the feature(s) canceled from the claim(s). The drawings (particularly Fig. 2) clearly disclose the connecting strips (123 and 124) mounted on a first edge portion of the mounting strip (122) and on a second edge portion of the printed paper (110), but not between. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: The specification does not disclose wherein “one or more discreted flexible connecting strips” are “mounted between the

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mounting strip and the printer paper sheet” as stated in Claim 8, lines 4 and 5, and in Claim 13, lines 2 and 3.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17-18 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Bristol (1,023,715).

Bristol discloses in Fig. 2-4, a hinge strip comprising: a discrete elongated mounting strip (24), a pair of discrete elongated flexible connecting strips (23) having a portion (23a) overhanging the elongated mounting strip (as see in Fig. 4) for mounting the connecting strip to an edge of a paper sheet (26).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (6,309,130).

Johnson et al discloses in Fig. 1, 6a-6c, a page comprising: a printer paper sheet (112); a hinge strip (10) mounted and securely attached (through adhesive edge strip (124)) along an edge of the printer sheet (seen in Fig. 6b); a bendable flexible portion (18) and a mounting portion (19) for mounting the page in an album; and wherein the hinge strip further includes a mounting strip (19B) space apart from the edge of the printer paper.

However, Johnson et al does not disclose: wherein the paper sheet and hinge strip are adapted to go through a printer together; paper sheet comprising a cotton rag paper material, uncoated, unbleached, 100% cotton fiber, acid-free; wherein the hinge strip is 100% acid-free; wherein the mounting strip is a linen tape; and wherein the mounting strip adhesive is an acrylic adhesive.

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In regards to **Claim 1**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, hinge strip of Johnson et al is capable and can be adapted to go through a printer together.

In regards to **Claims 2-5 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the hinge strip, adhesive, and paper sheet out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 8-13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol.

Bristol discloses in Fig. 1-4, a system of binding prints to an album comprising: a paper sheet (26); a hinge strip (A) which includes: a discrete elongated mounting strip (24), a pair of discrete elongated flexible connecting strips (23) mounted between the mounting strip and the paper sheet (Fig. 4) such that the hinge strip includes a flexible portion defined by a gap (G) between the mounting strip and the paper sheet.

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However, Bristol does not disclose: wherein the paper sheet and hinge strip are adapted to go through a printer together; a paper sheet comprising a cotton rag paper material, uncoated, unbleached, 100% cotton fiber, acid-free; wherein the hinge strip is 100% acid-free; and wherein the mounting strip adhesive is an acrylic adhesive.

In regards to **Claim 1**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, hinge strip of Bristol is capable and can be adapted to go through a printer together.

In regards to **Claims 2-5 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the hinge strip, adhesive, and paper sheet out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claim 19 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol in view of Pitts et al (4,961,666).

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Bristol discloses a hinge strip comprising all the elements as claimed in Claim 17, and as set forth above. However, Bristol does not disclose wherein the connecting strips includes a tape strip having an adhesive covered by a release tape.

Pitts et al discloses in Fig. 2, 4 and 6, a hinge strip having a tape strip (32) having adhesive (14) covered by a release tape (18).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bristol's hinge strips to include an adhesive tape strip with a release covering as taught by Pitts et al for the purpose of providing an alternative means of connecting the connecting strip to an edge of paper, and further to protect the adhesive.

Response to Arguments

8. Applicant's arguments filed on July 3, 2003 have been fully considered but they are not persuasive.

In regards to applicant's arguments that the Johnson et al reference does not disclose "a strip securely attached to a paper sheet allowing the page to go through a printer with the hinge strip attached", the examiner submits that Johnson et al does indeed disclose a strip securely attached to a paper sheet as recited above in the rejections. In regards to the intended use of "allowing the page to go through a printer with the hinge strip attached" as stated in applicant's

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argument or is “adapted to go through a printer together to provide a ready-to-bind printed page, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, hinge strip of Bristol is capable and can be adapted to go through a printer together.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Costello, Regenboog, Brody et al, Podeur, Leptre, Policht, Yamamoto, and Schleifenbaum et al disclose hinge strips for binding.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 17, 2003



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